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10/054,620	01/22/2002	Mitchell J. Rackovan	AVERP2544USA	7070

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EXAMINER

BRUENJES, CHRISTOPHER P

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 06/10/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/054,620

Applicant(s)

RACKOVAN ET AL.

Examiner

Christopher P Bruenjes

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6. 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

***Response to Amendment***

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

***WITHDRAWN REJECTIONS***

2. The 35 U.S.C. 112 rejection of claim 15 of record in Paper #5, Page 3 Paragraph 5 has been withdrawn due to Applicant's amendment in Paper #7.

3. The 35 U.S.C. 102 rejections of claims 1-8 and 10-17 of record in Paper #5, Pages 3-4 Paragraph 6 have been withdrawn due to Applicant's arguments in Paper #7.

4. The 35 U.S.C. 103 rejections of claims 18-19 of record in Paper #5, Pages 5-6 Paragraph 7 have been withdrawn due to Applicant's arguments in Paper #7.

***NEW REJECTIONS***

***Double Patenting***

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-8 and 10-19 are rejected under the judicially created doctrine of double patenting over claims 1-18 of U. S. Patent No. 6,436,496 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: A halogen-free, multilayered heat shrink film comprising a core layer comprising a blend of a copolymer of ethylene or propylene with an alpha olefin and a homopolymer of an olefin, and having an upper and lower surface, a skin layer on the upper surface of the core layer, wherein the skin

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layer comprises a polyolefin homopolymer or a blend of a polyolefin homopolymers and a copolymer of ethylene or propylene and an alpha olefin and a printable layer having an upper surface and a lower surface wherein the upper surface of the printable layer is in contact with the lower surface of the core layer, wherein the printable layer comprises a blend of a polyolefin and an additive, which is ethylene vinyl acetate, and wherein the shrinkage of the film is at least about 35%.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 1-8 and 10-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (USPN 6,322,883) in view of Dohrer (USPN 5,208,096).

Williams teaches a halogen-free multilayered heat shrink film comprising a core layer and at least one skin layer in which one of the skin layers is a printable layer (see abstract). The heat shrinkable film is used for labeling, covering, or packaging of materials and the film is printed on (col.1, 1.53-67). The shrinkage of the film is at least 35% (col.3, 1.40-45). The core layer comprises a blend of a copolymer of polypropylene and butene, in which the butene content is between 5 and 20% (col.3, 1.33-56 and col.4, 1.44-52), and a homopolymers of polypropylene (col.4, 1.44-52). The skin layer is formed from the same materials discussed above for the core layer (col.6, 1.35-44). The skin layer is found on

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both sides of the core layer and is not necessarily the same composition, for instance one of the skin layers is a polyethylene layer (col.7, 1.7-10) and one of the skin layers is printable making it a printable layer (col.8, 1.19-24).

Williams fails to explicitly teach adding an additive of ethylene vinyl acetate to the printable layer of polyolefin. However, Dohrer teaches that for films used to wrap and encapsulate articles ethylene vinyl acetate is added to polyolefin resins that do not inherently possess cling properties in order to provide the resin with cling properties (col.3, 1.66-68 and col.4, 1.1-15). One of ordinary skill in the art would have recognized that cling properties is a beneficial property to a film used to encapsulate an article, because that film can connect and continue to encapsulate the article without the need for adhesives. Furthermore, it is easier to remove a film having cling properties from an article than a film adhesively bonded to the article.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the applicant's invention was made to add ethylene vinyl acetate to the printable skin layer of Williams in order to provide the film with cling properties so that the film is better suited for encapsulating an article, as taught by Dohrer.

7. Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of Dohrer as applied to claims 16 and 17 above in further view of Call (USPN 4,756,415).

Williams and Dohrer combined teach all that is claimed in claims 16 and 17, and Williams teaches that heat shrink films are used for packaging or encapsulating articles such as boxes or cylindrical material, which are the same shape as batteries, but fail to explicitly teach the film for use in encapsulating a battery. However, Call teaches that it is known to use a shrink-wrap material for encapsulating a battery. Typically, this material is a polyethylene (or polyolefin) shrink film (col.3, 1.53-63). Call also teaches that shrink wrap especially of a polyolefin is used for wrapping a battery in order to prevent battery acid leakage during battery storage, handling and installation, and also having the qualities of transparency so that labels and warnings on the battery housing and cover are visible through the packaging and printability so warnings can be provided on the shrink wrap covering material.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to use the polyolefin shrink-wrapping film of Williams and Dohrer for packaging a battery, in order to prevent leakage as



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well as make the packaging transparent and printable, when polyolefin film wrapping material such as polyethylene is already known to wrap batteries as taught by Call.

***ANSWERS TO APPLICANT'S ARGUMENTS***

8. Applicant's arguments filed in Paper #7 regarding the 35 U.S.C. 112 rejection of record have been considered but are moot since the rejections have been withdrawn.

9. Applicant's arguments filed in Paper #7 regarding the 35 U.S.C. 102 rejections of claims 1-8 and 10-17 as anticipated by Josephy et al of record have been considered but are moot since the rejections have been withdrawn.

10. Applicant's arguments filed in Paper #7 regarding the 35 U.S.C. 103 rejections of claims 18-19 over Josephy et al in view of Call of record have been considered but are moot since the rejections have been withdrawn.

***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P Bruenjes whose telephone number is 703-305-3440.

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The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Christopher P Bruenjes  
Examiner  
Art Unit 1772

CPB

June 5, 2003



HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

6/9/03